

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

EXPEDITED HANDLING
RESPONSE UNDER RULE 1.116FAX RECEIVED
APR 3 2002
GROUP 1700

Appln. Ser. No.:	Filed:	Inventor(s):	Atty Dkt:
09/074,012	5 May 1998	YOSHIDA <i>et al.</i>	114GI-135 (0694-121)
Title: Highly Heat-Conductive Composite Magnetic Body			
Ex: B. Pianalto		Art Unit: 1762	

Asst. Comm'r for Patents
Washington, D.C. 20231-00013 Pages Total VIA FACSIMILE
703-872-9311

RESPONSE AFTER FINAL REJECTION

Dear Sir:

In complete and timely response to the Office Action dated 7 January 2002 in which the rejections were designated as final, reconsideration is respectfully requested in light of the following remarks.

The rejections are based on anticipation by Hartman or Goto or Takahashi, or on obviousness over the combination of Goto and Horie, alone or in combination with Hartman and Takahashi. These rejections are traversed.

First, the Examiner alleges that "nowhere in the four corners of applicants' claim 10 can 'separate' be found." This contention ignores the plain language that the article is "comprised of soft magnetic powder . . . and also including a heat conductive powder." Claim 10 clearly recites two powders. An interpretation of the claim that only a single powder is recited is inconsistent with the dual recitations of "powder" and that each powder is referenced by its properties (soft magnetic and heat conductive). Accordingly, there are two powders recited and the claim is distinguishable from the references. One does not need to read limitations from the specification into the claims to divine that the

claim recites a composition including a first powder and also including a second powder.

Next, regarding the recitation of a stationary article, the Examiner fails to address the fact argued previously, that material used for electromagnetic interference suppression cannot be used for a magnetic recording media, and hence the claimed stationary article inherently has a structure that, if rotated about its axis, would not function as required by the cited reference. Thus, as to the issue of obviousness, that the claimed structure is stationary is an important consideration for whether it would have been an obvious structure in light of the prior art teaching, and as the prior art is directed to moving media with certain electromagnetic requirements, it would not have been obvious to eliminate those features necessary to the functioning of the prior art articles. *Carl Schenck, A.G. v. Nortron Corp.*, 218 USPQ 698, 700 (Fed. Cir. 1983) (citing *United States v. Adams*, 383 U.S. 39, 148 USPQ 479 (1966)); *In re Meunier*, 168 USPQ 43 (CCPA 1970).

Iron can be present in both hard and soft magnetic devices. However, the soft magnetic materials exemplified in this application are iron alloys. Iron *per se*, as in the "iron core" of Hartman, is a hard magnetic material.

Even if the prior art were capable of performing the intended use, which is not conceded, it is the Office's policy that intended use of a structure or composition is not probative of the obviousness of the structure or composition *per se*.

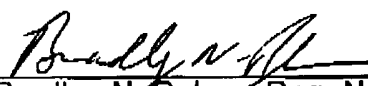
The Examiner's comments on a process for making are not understood, as claims 10-21 are directed to a structure. Further, claims directed to a method of using are linked to the patentability of the material used, but claims directed to a process of making must be based on the process steps themselves and not the subsequent use of the material. *Ex parte Ochial*, 24 U.S.P.Q.2d 1265 (BPAI

1992). Claims 22-27 are akin to a process of making a structure that suppresses magnetic waves.

The present case has been transferred to the undersigned, and so this response is filed under 37 C.F.R. 1.34(a). As a revocation and new power of attorney will be submitted in the near future, the Examiner is requested to contact the undersigned at the address and telephone number shown below if desired to discuss any aspects of this case.

In light of the foregoing, withdrawal of all of the rejections, and further and favorable action, in the form of a Notice of Allowance, are believed to be next in order, and such actions are earnestly solicited.


Respectfully submitted,


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3 April 2002

**CERTIFICATE OF MAILING OR
TRANSMISSION – 37 CFR 1.8**

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D C. 20231, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: 3 April 2002
NAME: Brad Ruben
SIGNATURE: 

09/074,012

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